



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,863	02/16/2001	Jafar Nabkel	020366-066900	6341

20350 7590 02/11/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

AL AUBAIDI, RASHA S

ART UNIT	PAPER NUMBER
----------	--------------

2642

DATE MAILED: 02/11/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

27

Office Action Summary

Application No.

09/785,863

Applicant(s)

NABKEL ET AL.

Examiner

Rasha S AL-Aubaidi

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8-16, 19-27 and 30-38 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1-5, 8-16, 19-27 and 30-38 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Response to Amendment

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 8-16, 19-27 and 30-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod et al (US PAT# 5,222,120) in view of Kung et al. (US PAT #6,373,817).

Regarding claim 1, McLeod teaches a communication network comprising a plurality of subscriber telephone lines (see col.2, lines 18-20), each coupled to an associated telephoning switching facility, each subscriber telephone line having at least one directory number and an associated subscriber profile including selected information services, a method for providing information services to a subscriber, comprising: detecting an off-hook condition at a subscriber telephone line (this feature is inherent) ; determining the information services selected by the subscriber (reads on customer profile, see col.24, lines 45-57) by correlating the subscriber directory number with the selected information services in the subscriber's profile("customer data record" or "information system") in accordance with predetermined criteria (see col.4, lines 29-

Art Unit: 2642

32) ; generating a message corresponding to the selected information services for receipt by the subscriber. “ The predetermined criteria includes the time, date or day of the week” in the subscriber’s profile would obviously reflect how often a service such as the news or the weather would be provided. The subscriber would obviously not want to listen to the weather report every 5 minutes.

McLeod does not teach generating a message “in response to the off-hook condition” detection.

However, Kung et al teach the announcement server 220 may detect the off-hook condition of the phone and play advertisements or other announcements to the user, (see col. 10, lines 13-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of generating a message or an announcement in response to an off hook detection, as taught by Kung, into the McLeod’s system in order to provide the user with the convenience of accessing the required service such as the news, updates of the stock market, or the weather without the need to dial or memorize any access number. Also, Kung teaches a business agreement such as reduced phone rates may be provided to users who agree to listen to announcement when they go off-hook.

Claims 16 and 27 are rejected for the same reasons as respect to claim 1.

Regarding claim 2, McLeod teaches the message is an audio message (see col.24, lines 29-39).

Regarding claims 9,10, 20,21,31, and 32, McLeod teaches that while receiving the message, or after the message completes, entering one of a plurality of codes by the subscriber accesses additional information, and entering a code by the subscriber accesses the subscriber's correspondence messaging service (see col.24, lines 58-68).

Regarding claims 12,23, and 35 McLeod teaches the communication network is a public switched telephone network.

Regarding claims 14, 25 and 36, McLeod teaches that the subscriber selects an appropriate calling number by generating DTMF (dual tone multi-frequency) tones (see col. 25, lines 43-45).

Regarding claims 15, 26, and 37, the message is terminated when the subscriber goes "on hook" by hanging up the line. (The feature is inherent in McLeod; hanging up will end the transmission of the message).

Regarding claims 3-5; the use of different types of messages such as text, video, and graphic message would have been obvious to one of ordinary skill in the art at the time the invention was made since the use of multimedia messages is well known and desired.

Regarding claims 8, 19, and 30, for the predetermined criteria includes the time since the last detected "off-hook" condition. This simply reads on the subscriber's choice of having the service provided during certain times or after making certain number of phone calls. This also may be an agreement between the business and the subscriber in Kung.

Regarding claims 13, 24, and 35, for selecting an appropriate calling number by the subscriber terminates the message. This is obvious because dialing should step the announcement.

Regarding claims 11,22, and 33, having the communication-network is an advanced intelligent network (AIN) this simply reads on using the features in an advanced intelligent network.

Claim 38 is rejected for the same reasons as discussed above with respect to claim 1.

Response to Arguments

2. Applicant's arguments filed 01-21-2003 have been fully considered but they are not persuasive.

Applicants argues, " The predetermined criteria includes the time, date or day of the week" and disagrees with the office action. Examiner had explained in the rejection above, that the subscriber's profile would obviously reflect how often a service such as

Art Unit: 2642

the news or the weather would be provided. The subscriber would obviously not want to listen to the weather report every 5 minutes. Customizing services based on the customer's profile is well known in the art.

Applicant also disagrees about the rejection for claims 8, 19 and 30 that include the limitation of "the predetermined criteria include the time since the last detected "off-hook" condition". This is similar to the above argument. If the last time the customer went off hook was 5 minutes ago, then the weather should not be played. Again, these features should obviously be convenient and helpful to the customer and should not annoy the customer. Further, in a business agreement (as suggested by Kung), the customer may agree to receive this service if, for example advertisements are provided only during the weekend.

Conclusion

3. This is an RCE of applicant's earlier Application No. 09785863. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (703) 605-5145. The examiner can normally be reached on Monday- Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.


Application/Control Number: 09/785,863
Art Unit: 2642

Page 8

Examiner

Rasha S Al-Aubaidi

05-02-2003


AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700